

REMARKS

Claims 1-4, 6-10, 13-19, 22-28, 31-32, and 34-39 are pending in the application. Claims 6-10, 13-14, and 34 are allowed. Claims 1-4, 15-19, 22-28, 31-32, and 34-39 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Reconsideration is requested. The rejections are traversed. No new matter is added. Claims 15-19, 22-23, and 36 are amended. Claims 24-28, 31-32, and 37 are canceled. Claim 40 is added. Claims 1-4, 6-10, 13-19, 22-23, 34-36, and 38-40 remain in the case for consideration.

On the Office Action Summary page of the Office Action dated September 17, 2007, the Examiner indicates that “claims 1-4, 6-10, 13-19, 22-28, 31, 32, and 34-38 is/are pending in the application”. This is incorrect. On the same Office Action Summary page, the Examiner indicates that claim 39 is rejected. Claim 39, which was added in response to the Office Action dated April 13, 2007, has not been canceled and is also pending.

The Examiner’s rejection of claims 34 and 35 is inconsistent or incomplete. On the Office Action Summary page of the Office Action dated September 17, 2007, in the section headed “Disposition of Claims”, the Examiner has listed 34 as allowed, not as rejected, and has listed claim 35 as rejected, not as allowed. Then, in the rejections under 35 U.S.C. § 101, the Examiner indicates that claims 34-35 (among others) are rejected. But in the body of the rejection, the Examiner specifically mentions only claim 34, not claim 35 (*see* Office Action dated September 17, 2007, page 3). Then in listing the allowable subject matter, the Examiner again indicates that claim 34 is allowable (*see* Office Action dated September 17, 2007, page 4).

Claim 34 depends from claim 2, which in turn depends from claim 1, which has been rejected under 35 U.S.C. § 101. In contrast, claim 35 depends from claim 6, which has been allowed (*see, e.g.,* Office Action Summary and Office Action dated September 17, 2007, pages 3-4).

The Applicant believes the Examiner has partially scrambled the actual status of claims 34 and 35. Based on the fact that claim 34 is mentioned in the body of the rejection under 35 U.S.C. § 101 and claim 35 is not, the Applicant interprets the Office Action to reject claims 1-4, 15-19, 22-28, 31-32, 34, and 36-39 under 35 U.S.C. § 101, and to indicate that claims 6-10, 13-

14, and 35 are allowed. If the Applicant has misinterpreted the Examiner's intent, the Applicant respectfully requests the Examiner to issue a new Office Action.

REJECTIONS UNDER 35 U.S.C. § 101

The Examiner rejects claims 1-4, 15-19, 22-28, 31-32, and 34-39 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Applicant respectfully disagrees. As discussed above, the Applicant treats claim 35 as allowed, and thus only claims 1-4, 15-19, 22-28, 31-32, 34, and 36-39 are treated as rejected under 35 U.S.C. § 101.

Regarding claims 1-4, 34, and 38-39, the Examiner rejects claim 1 because "it has no recited input nor output capability for the apparatus, and thus involves only internal processing of data involving two computers, without transforming an article or physical object to a different state or thing, nor producing a result which has a real-world practical application/use" (*see* Office Action dated September 17, 2007, page 3). This is an incorrect analysis. First, claim 1 is directed to an apparatus. Under the Interim Guidelines, "[a] claim limited to a machine or manufacture, which has a practical application, is statutory" (*see* Interim Guidelines (Annex II), page 38). No further discussion is provided, other than citations to *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994) (en banc), *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998), and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999). Given that claim 1 is directed to a machine, it would appear that these claims are, under both the Interim Guidelines and cited cases, patentable without amendment. Further, the apparatus of claim 1 has a practical application or use: namely, "determining a language for a user" (*see* claim 1).

The Examiner's argument that the apparatus of claim 1 lacks input or output capability is irrelevant. An apparatus can have an implicit input or output capability and be patentable without explicit recitation of such elements. Further, many apparatuses are patentable without having input or output capability. For example, a basketball, as an apparatus, does not have input or output capability, but is still patentable subject matter.

The Examiner's argument that claim 1 only involves "internal processing of data" is also irrelevant. The apparatus of claim 1, when being used, might only support internal processing of data (although this assertion by the Examiner cannot be correct since the two computers recited in claim 1 are communicating: "second computer from which the first computer can be

accessed”). But the Examiner is analyzing the apparatus of claim 1 as though it were implementing a method. This is the wrong question to ask. The question is not whether the apparatus of claim 1 only supports internal processing of data: the question is whether the apparatus of claim 1 is patentable subject matter in its own right: Is it a useful machine? Claim 1, as an apparatus claim, is patentable subject matter by itself; how it might be used, and whether a method using the apparatus might be patentable, is irrelevant. Thus, claim 1 is patentable under 35 U.S.C. § 101 and is allowable, as are dependent claims 2-4, 34, and 38-39.

Regarding claims 15-18, 22-23, and 36, the Examiner rejects claim 15 because “it claims ‘computer-readable media’, which, according to the Specification (p. 9, line 21), includes a nonstatutory ‘modulated carrier signal’, and does not recite the ‘program’ is a ‘computer program’” (see Office Action dated September 17, 2007, page 3).

The Applicant has amended claim 15 to describe the “program” as a “computer program”. However, the Applicant believes this amendment is not necessary to make the claim allowable, as a person skilled in the art would recognize that a “program” on a “computer-readable media” would be a “computer program”.

Regarding the Examiner’s statement that “computer-readable media” includes a nonstatutory “modulated carrier signal”, the Applicant respectfully traverses the Examiner’s rejection. While it is true that a “modulated carrier signal” is recited in the same paragraph as the “computer-readable media”, a person skilled in the art would recognize “computer-readable media” would not include a modulated carrier signal. The specification recites that “the program can be stored on computer-readable media, such as floppy disks, optical disks (such as compact discs), or fixed disks (such as hard drives). The program can then be executed on a computer to implement the method” (see Specification, page 9, lines 17-19). The “computer-readable media” is clearly directed to physical constructs that can store a program, and would therefore not include a “modulated carrier signal”. In fact, the “computer-readable media” and the “modulated carrier signal” are described as belonging to different embodiments of the claimed invention.

The Applicant has also added new dependent claim 40, which describes the “computer-readable media” as being “drawn from a set consisting of floppy disks, optical disks, and fixed disks”, which the Applicant believes should further help clarify the claims.

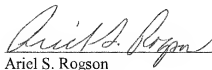
Finally, the Applicant points out that claim 24 was directed to a “modulated carrier signal”. If the “computer-readable media” of claim 15 included a “modulated carrier signal”, as the Examiner suggests, then claim 24 would have been redundant in light of claim 15. Therefore, based on the doctrine of claim differentiation, the “computer-readable media” of claim 15 could not have been directed to a “modulated carrier signal”, as the Examiner suggests.

Claims 24-28, 31-32, and 37 are canceled, which renders the rejection of these claims under 35 U.S.C. § 101 as moot.

For the foregoing reasons, reconsideration and allowance of claims 1-4, 6-10, 13-19, 22-23, 34-36, and 38-40 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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A handwritten signature in cursive script, appearing to read 'Ariel S. Rogson', is written over a horizontal line.

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